



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/855,036	05/01/92	REEVE	M 263-GB910021

REARDON, EXAMINER

18N1/0720

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ART UNIT PAPER NUMBER

1815

DATE MAILED: 07/20/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 11/17/92 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice re Patent Drawing, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☒ Notice of Informal Patent Application, Form PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

1. ☒ Claims 1-12 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-12 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).

12. ☒ Acknowledgment is made of the claim for priority under U.S.C. ^{37/}419. The certified copy has ☒ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Art Unit 1815

1. The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1815.

5 Claims 1-12 are considered on the merits.

2. Acknowledgment is made of applicant's claim for priority based on an application filed in Britain on 2/13/90.

10 The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by its Serial Number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.

The oath or declaration is defective because:

15 Applicant's residence has been omitted from the papers. The city and state of applicant's post office address will be presumed to be the city and state of the residence. If the above is incorrect, applicant should submit a statement as to place of residence no later than at the time of payment of the issue fee.

20 The present specification is not properly identified because it is listed on the declaration by a different title than appears in the specification.

The oath is stale.

25

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

30 The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains,

Art Unit 1815

or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 9-11 are rejected under 35 U.S.C. § 112, first
5 paragraph, as the disclosure is fully enabling only for claims limited to the procedures demonstrated in Examples 1-3. These examples show, apparently successfully, the present method applied to a variety of target substances: a sample of nucleic acid, a sample of nucleic acid with protein and a sample of
10 phage. Each of these examples was performed on a clean, artificial mixture of the target substance and the qualitative results were stated. The remaining examples are speculative in nature as they appear to be laboratory protocols presented without even qualitative results. The present disclosure is not
15 adequate to enable the many other biopolymers, let alone non-biopolymers, encompassed by the present claim language. For instance, the isolation of nucleic acid from lysate or the isolation of blood cells from whole blood present far more challenging and impure mixtures than those demonstrated to date.
20 See M.P.E.P. §§ 706.03(n) and 706.03(z).

4. Claims 1-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant
25 regards as the invention.

Art Unit 1815

The Markush group in claim 8 is not proper. Examiner recommends replacing the term "polymer" in claim 1 with a proper Markush group composed of the elements cited in claim 8. See MPEP 706.03(y).

5 The term "treating" in claim 1 is too vague in describing the intended method.

Claim 5 lacks antecedent basis in claim 1. Claim 6 attempts to add further to the composition of claim 4, however, claim 4 is presented in closed language that limits the composition to a single biopolymer.

Claim 7 is confusing. Perhaps the phrase --and the associated nucleic acid-- should be inserted in line 5 after "beads".

Claims 11 and 12 should be rewritten to US practice by including those steps referenced by phrases such as "by the method of Claim 8".

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6 and 8-9 are rejected under 35 U.S.C. § 102(b)

Art Unit 1815

as anticipated by Warren et al (USP 3470067).

See column 2 through column 3 line 20, the claims and Example XV of Warren et al. Here is taught the use of magnetic particles to non-specifically bind viral particles for the separation of the viral particles from egg fluids. Examiner notes that no evidence of specific binding is provided by the reference. The Patent and Trademark Office is not equipped to conduct experimentation in order to determine whether or not specific binding occurs in the method of Warren et al.

Therefore, the burden of establishing this fact by objective evidence is shifted to Applicant.

6. Claims 1, 3, 6, 8 and 12 are rejected under 35 U.S.C. § 102(b) as anticipated by Mitchell et al (USP 4001197).

See the abstract, column 2 and Figure 1 of Mitchell et al. Here is taught the use of magnetic particles to non-specifically bind to microorganism cells to separate them from a fluid medium. Examiner notes that the automatic valve and magnetic separator of Figure 1 read on the automatic pipette and magnet of the present claim 12.

7. No claims are allowed.

The remaining references listed on the enclosed PTO-892 are cited to further show the state of the art.

Serial No. 07/855036

-6-

Art Unit 1815


Any inquiry concerning this communication or earlier communications from the examiner should be directed to the Group 180 receptionist whose telephone number is (703) 308-0196.

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Timothy J. Reardon
June 28, 1993

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MICHAEL G. WITYSHYN
SUPERVISORY PATENT EXAMINER
GROUP 1800

7-17



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER

FILING DATE

FIRST NAMED APPLICANT

ATTY DOCKET NO./TITLE

DATE MAILED:

NOTICE OF INFORMAL APPLICATION

(Attachment to Office Action)

This application does not conform with the rules governing applications for the reason(s) checked below. The period within which to correct these requirements and avoid abandonment is set in the accompanying Office action.

A. A new oath or declaration, identifying this application by the application number and filing date is required. The oath or declaration does not comply with 37 CFR 1.63 in that it:

1. ☐ does not identify the city and state or foreign country of residence of each inventor.
2. ☐ does not identify the citizenship of each inventor.
3. ☐ does not state whether the inventor is a sole or joint inventor.
4. ☐ does not state that the person making the oath or declaration:
 - a. ☐ has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
 - b. ☐ believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
 - c. ☐ acknowledges the duty to disclose information which is material to the examination of the application in accordance with 37 CFR 1.56(a).
5. ☐ does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.
6. ☐ does not state that the person making the oath or declaration acknowledges the duty to disclose material information as defined in 37 CFR 1.56(a) which occurred between the filing date of the prior application and filing date of the continuation-in-part application which discloses and claims subject matter in addition to that disclosed in the prior application (37 CFR 1.63(d)).
7. ☐ does not include the date of execution.
8. ☐ does not use permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a).
9. ☐ contains non-initialed alterations (See 37 CFR 1.52(c)).

10. ☒ Other: P.O. BOX 121120
OF RESIDENCE
TITLES INCONSISTANT

B. Applicant is required to provide:

1. ☐ A statement signed by applicant giving his or her complete name. A full name must include at least one given name without abbreviation as required by 37 CFR 1.41(a).
2. ☐ Proof of authority of the legal representative under 37 CFR 1.44.
3. ☐ An abstract in compliance with 37 CFR 1.72(b).
4. ☐ A statement signed by applicant giving his or her complete post office address (37 CFR 1.33(a)).
5. ☐ A copy of the specification written, typed, or printed in permanent ink, or its equivalent in quality as required by 37 CFR 1.52(a).
6. ☐ Other: